

REMARKS

Claims 16-42 are pending and claims 16-38 and 42 have been examined on the merits.

Claim 42 is amended hereinabove to correct a minor typographical error. No new matter has been added.

In the Office Action, the claims are rejected as follows:

- A) Claim 42 is rejected under 35 U.S.C. § 112, ¶ 2, for allegedly being indefinite;
- B) Claims 16, 20, 21, 23 and 38 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over EP 1,074,243 to Pantini (hereinafter “Pantini) in view of U.S. Patent No. 6,066,311 to Cheetam et al. (hereinafter “Cheetam”);
- C) Claims 17, 18, 19, 22 and 24 stand rejected and claim 42 is rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Pantini and Cheetam as applied to claims 16, 20, 21, 23 and 38 above, and further in view of Schliemann-Willers as published in *Acta Dermato-Venereologica* in 2001 (hereinafter “Schliemann”) and as evidenced by the Fomblin HC/P2-1000 product information sheet as dated 09/2005 by Solvay Solexis (hereinafter “Fomblin”);
- D) Claims 25-30 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Pantini, Cheetam, Schliemann and as evidenced by Fomblin, as applied to claims 16-24 38 and 42 above and further in view of U.S. Patent No. 5,945,090 to Randall et al. (hereinafter “Randall”);
- E) Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Pantini, Cheetam, Schliemann and Randall as evidenced by Fomblin and further in view of U.S. Patent No. 6,015,548 to Siddiqui et al. (hereinafter “Siddiqui”); and

- F) Claims 31-34 and 37 have been rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Pantini, Cheetam, Schliemann, Randall and Siddiqui as evidenced by Fomblin and further in view of U.S. Patent No. 6,007,796 to Menzel et al. (hereinafter “Menzel”).

Applicant respectfully traverses the rejections.

As an initial matter claim 42 is amended hereinabove to correct a minor typographical error. Thus, the rejection over 35 U.S.C. § 112, ¶ 2, is now moot.

Rejection over Pantini and Cheetam

As presently submitted, the presently claimed invention is directed to a composition comprising polyphenols and an amount of a stabilizing perfluoropolyether capable of preventing the oxidative degradation of the polyphenols.

As also previously submitted, Pantini does not disclose a composition having polyphenols and an amount of a stabilizing perfluoropolyether.

Pantini only provides for monobasic concentrated compositions containing (per)fluoropolyethers which are added to emulsions oil/water or water/oil for obtaining stable emulsions (*e.g.*, page 2, paragraph [0001] and page 5, paragraph [0031]). These emulsions are considered stable in that no separation of phases occurs (*e.g.*, page 5, paragraph [0031]).

Pantini is completely silent with regards to polyphenols and completely silent with regard to oxidative degradation.

Cheetam does not make up for Pantini’s deficiencies because it suffers from the same defects. Namely, Cheetam only discloses the use of caffeic acid and derivatives as sunscreen additives (*e.g.*, col. 1, lines 3-5).

In the Final Office Action, the Examiner has taken the position that the fact that Pantini

describes the same perfluoropolyether phosphate disclosed in the Examples 1-3 of the present application is sufficient to provide the motivation to combine the teachings of Pantini and Cheetam. Applicant respectfully disagrees with this reasoning.

As set forth above, Pantini discloses “stability” in the context of “emulsion stability” wherein the two phases do not separate. Nowhere Pantini discusses the need to prevent oxidative degradation nor does Cheetam contain any teaching or hints concerning polyphenols degradation.

Moreover, Pantini describes that the compositions could be used for skin protection against irritating agents, for the hair protection and treatment, for the protection against sun radiations, for detergency, as deodorants, after-shaves, disinfectants for external use, make-up compositions and for the nail-varnish removal (*e.g.*, page 4, paragraph [0025]). Accordingly, a person skilled in the art would not know to what of the many composition’s applications described by Pantini adding the teachings of Cheetam as alleged by the Examiner to sustain the *prima facie* case of obviousness.

It is settled law that obviousness can be established only by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, motivation to do so. *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). For the following reasons, it is respectfully submitted that the Examiner’s reasoning to establish obviousness is circular and therefore flawed.

As set forth above, a person skilled in the art would not know to which of the many uses described by Pantini adding the caffeic acid described in Cheetam, because certainly there is no motivation to add caffeic acid to obtain advantageous UV absorption in a deodorant or nail-varnish removal. Thus, only if the Examiner’s rejection is based on the impermissible hindsight the combination of Pantini with Cheetam would have rendered obvious the presently claimed subject

matter.

Moreover, the Examiner's comment that "the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious" is also erroneous (*e.g.*, Final Office action page 5).

None of the cited references provides a hint of suggestion or motivation to combine the caffeic acid of Cheetam with the perfluoropolyether phosphates of Pantini. Thus, the advantages provided by the presently claimed invention had not been recognized by the prior art, and therefore, the cited references would not have rendered obvious the present invention to one skilled in the art. *In re Omeprazole Patent Litigation*, 536 F.3d 1361 (Fed. Cir. 2008).

Accordingly, for these additional reasons, a person skilled in the art would have found no motivation to introduce the caffeic acid disclosed in Cheetam in the emulsion made from the concentrated composition disclosed in Pantini.

As such, it is submitted that the presently claimed invention is non-obvious over the combination of Pantini and Cheetam and withdrawal of the rejection of claims 16, 20, 21, 23 and 38 under 35 U.S.C. § 103(a) is respectfully requested.

If an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). As claims 17-38 and 42 all depend, either directly or indirectly, by claim 16 which is not rendered obvious by the combination of Pantini with Cheetam in view of Schliemann-Willers, the Fomblin HC/P2-1000 product information, Randall, Siddiqui and Menzel, it is respectfully submitted that claims 17-38 and 42 are also patentable over the additional references' combinations .

Thus, Applicant respectfully submits that the pending claims are all in condition for

allowance and a Notice to that effect is respectfully requested.

This response is being filed within the shortened period for response. Thus, no extra fees are believed to be due. If, on the other hand, it is determined that further fees are necessary or any overpayment has been made, the Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. § 1.136(a), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time of its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated herewith is to be charged to the above-mentioned deposit account.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted

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